

### DETAILED ACTION

1. This Office Action is the answer to the communication filed on 11/14/2008 which papers have been placed of record in the file.
2. Claims 1-7, 9, 11-12, 14-18, and 20-21 are pending in this application (claims 8, 10, 13, and 19 were canceled).

### *Response*

3. Since pending claims are amended that clearly directing to 2 different subject matters in a claimed set; i.e., a data product (i.e., a computer program imbedded in a computer-readable medium – e.g., see claim 2, lines 1-2, and a map data processing apparatus (see claim 21, line 1); they have different scopes - the examiner is regret for any inconvenience this may cause.

About manner of claiming (for a clear and concrete claim):

According to MPEP,

- I. The definition of the matter for which protection is sought shall be in terms of the technical features of the inventions (i.e., “a computer-readable medium” containing a program and “a map data processing apparatus” (see claim 21) – therefore, a claimed subject matter of updatable map information in a computer-readable medium, which containing well-known limitations (these are not limitations of claim 1 “...information indicating whether information pertaining to the information element is valid or invalid; and the identification information of an information element that has been updated and become old is set invalid.” Since those are well-known non-functional descriptive material that do not explicitly supported – i.e., where is “readable” data/instructions by a “computer” as claim1 lines 1-2?.
- II. Whenever appropriate, claims shall contain:

- III. I. A statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,
- IV. II. A characterizing portion – preceded by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or any other words to the same effect – stating concisely the technical features which, in combination with the features stated under (I), it is desired to protect.
- V. Where the national law of the designated State does not require the manner of claiming provided for in paragraph (b), failure to use that manner of claiming shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

The claims must “define the matter for which protection is sought.” As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought (“the characterizing portion”). The physical requirements for the claims are the same as those for the description.

***Claim Rejections- 35 USC §112***

- The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, and 21 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The claim is directed to a map data processing apparatus, and it is dependent on claim 20 that directed to a computer-readable product (see claim 21, line 4); therefore, it is unclear.

If claim 21 is an independent claim, claim 20 should not be involved in any place within claim 21.

The examiner interprets Claim 1's limitation to only see following limitations: map-related information (note: something else must do a compilation/update/compare to see valid/invalid of those information). Therefore, claim 1's limitations are unclear.

#### ***Election/Restrictions***

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Group I B<sub>sp</sub>: claims 1-7, 9, 11-12, 14-18, and 20 for a computer product (e.g., a floppy disk).

- Group II AB<sub>br</sub>: claim 21 for a computer system containing a data product of claim 20.

The inventions are distinct, each from the other because of the following reasons: Inventions group II and I are related as **combination and sub-combination**. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patent-ability, and (2) that the sub-combination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed because claimed combination (e.g., a computer system) not essential to sub-combination (e.g., a floppy disk), AB<sub>br</sub>/B<sub>sp</sub> Restriction is proper.

The claimed apparatus of group I (sub-combination) recites limitations of: “map data including map-related information related to a map, wherein:

the map-related information includes a compilation of a plurality of information elements; the map-related information being updateable in units of the individual information elements at the map data processing apparatus; the map-related information includes management information used to manage the map-related information, which is also updated when the map-related information is updated in units of the individual information elements” (which is a Bsp (Bspecific)), and A representing by these following limitations: “a nonvolatile memory; an update data acquisition unit that acquires update data used to update map-related information in units of the individual information units and stores the update data into the nonvolatile memory; and

a processing unit that processes map data based upon the map data recorded in the recording medium and the update data stored in the nonvolatile memory.”

which indicates that in the combination, AB<sub>br</sub>, the sub-combination, B<sub>br</sub>, is broadly recited (i.e., “a recording medium drive unit having loaded therein a recording medium that is a data product according to claim 20” – see claim 21, lines 3-4), and that the specific characteristics set forth in the sub-combination claim, group I, is directed to a computer-readable data product, comprising: map data including map-related information related to a map, wherein: the map-related information includes a compilation of a plurality of information elements the map-related information being updateable in units of the individual information elements at the map data processing apparatus; and the information elements each include identification information indicating whether information pertaining to the information element is valid or invalid; and the

identification information of an information element that has been updated and become old is set invalid”(which is specific, Bsp (Bspecific)) are not set forth in the combination claim.

Since claims to both the sub-combination and combination are presented and assumed to be patent-able, the **omission of details of the claimed sub-combination B<sub>sp</sub> (group I) in the combination claim AB<sub>br</sub> (group II) is evidence that the patent-ability of the combination does not rely on the details of the specific sub-combination.** The sub-combination has separate utility such as for (new application) device/system.

Alternatively, applicants claim 2 different species representing groups I, and II.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 7:30 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3661

**/CUONG H. NGUYEN/  
Primary Examiner  
Art Unit 3661**